

III. Remarks

Reconsideration and allowance of the subject application are respectfully requested.

Applicant has amended Claims 1-6 to define more clearly the invention. The nature of these amendments will be apparent in discussion below concerning the various objections raised by the Examiner in Paper Number 14.

Applicant has cancelled Claims 15-19 which were withdrawn by the Examiner in Paper Number 8.

Claims 20-34 are newly presented. Claims 20 and 27-34 are supported by Example 3 on pages 20-22 of the present application. Claims 21-24 correspond to the format of original claims 9-12, adapted for the pain indication. Claims 25-26 are supported on page 14, line 7 of the present application.

Accordingly, Claims 1-7, 9-14 and 20-34 are currently pending in the present application. Claims 1, 6 and 20 are independent. It is believed that no new subject matter has been added by the amendments submitted herewith.

The undersigned would like to thank Examiner Huang for the cordial and productive interview of September 17, 2003. The Examiners' helpful comments and suggestions were instrumental in preparing this response. Applicants would like to note the Examiner's dedicated

professionalism by conducting the interview on relatively short notice in advance of an approaching hurricane (Isabel), and being so well prepared at the interview. The Examiner's performance reflects the highest credit on the PTO and GAU 1625.

Preliminarily, Applicant wishes to state the amendments made herein are made without prejudice and should not be confused with acquiescence to the propriety of the objections and rejections raised by the Examiner. Applicant reserves its rights to prosecute any claim canceled during prosecution of the present application (or any similar claim) in this or a related patent application.

In Paragraph 2 of Paper Number 14, the Examiner acknowledges the claim for foreign priority based on United Kingdom applications filed on October 21, 1996 and May 27, 1997. The Examiner noted that certified copies of the foreign applications had not been filed as required by 35 U.S.C. §119(b). As discussed at the recent personal interview, Applicant submits herewith certified copies of United Kingdom patent applications 9621902.7 (filed October 21, 1996) and 9710904.5 (filed May 27, 1997), from which the present application claims foreign priority. The Examiner is requested to formally acknowledge the claim to priority of the filing dates of these foreign applications.

In Paragraph 3 of Paper Number 14, the Examiner maintains the restriction requirement made in Paper Number 8. Applicant has cancelled withdrawn Claims 15-19 but has maintained withdrawn Claim 14. As discussed at the recent personal interview, Applicant submits

that Claim 14 is not directed to an invention different from that defined in Claim 1. In fact, Claim 14 depends from Claim 1 and, by definition, recites a preferred embodiment of the subject matter of Claim 1. The Examiner is requested to reconsider and withdraw the restriction requirement as it relates to Claim 14.

With reference to Paragraphs 4, 6, 7, 8 (in part) and 9 of Paper Number 14, Applicant gratefully acknowledges withdrawal of various prior art rejections raised in Paper Number 8.

In Paragraph 5 of Paper Number 14, the Examiner restates the provisional obviousness-type double patenting objection set out in Paper Number 8 as an obviousness-type double patenting objection over United States patent 6,492,380. The objection is traversed. Reconsideration is requested in the light of the following remarks.

To substantiate the objection, the Examiner focuses on the embodiment of Claim 1 of the present application wherein R^1 is “loweralkyl carbonate” and reasons that, based on page 9 of the specification, this term includes the case where R^1 is “acetic acid” (it is believed the Examiner meant to refer to the case where R^1 is an acetate group). As discussed at the recent personal interview, “carbonate” refers to a CO_3 group (e.g., carbonic acid = H_2CO_3) and “loweralkyl carbonate” therefore describes a structure where “lower alkyl” replaces one of the hydrogen atoms in H_2CO_3 . Thus, for example, a methyl carbonate group would be one where methyl is attached to an sp^3 -hybridized oxygen attached to a carbonyl group that has one other sp^3 -hybridized oxygen bonded to it:



By contrast, acetic acid [$\text{CH}_3\text{C}(\text{O})\text{OH}$] is a carboxylic acid not at a carbonic acid. Thus, using the above nomenclature, the acetic acid/acetate group would be a “loweralkyl carboxylate” not a “loweralkyl carbonate”. Applicant submits that this distinction sets a clear line of demarcation between Claim 1 of the present application and the claims of United States patent 6,492,380.

The Examiner is requested to reconsider and withdraw the obviousness-type double patenting objection over United States patent 6,492,380.

In Paragraph 8 of Paper Number 14, the Examiner maintains the rejection of Claims 1-4 and 9-12 under 35 U.S.C. §103(a) as being purportedly unpatentable over Sestanj I in view of Malizia. This rejection is traversed. Reconsideration is requested in the light of the following remarks. To substantiate the rejection, the Examiner focuses on the embodiment of Claim 1 of the present application wherein R^1 is “loweralkyl carbonate” and sets forth an analysis similar to that discussed above in relation to Paragraph 5 of Paper Number 14. Accordingly, Applicant incorporates herein the above remarks in reply to Paragraph 5 of Paper Number 14 concerning the definition of “loweralkyl carbonate”. The Examiner is requested to reconsider and withdraw the rejection of Claims 1-4 and 9-12 under 35 U.S.C. §103(a) as being purportedly unpatentable over Sestanj I in view of Malizia.

With reference to Paragraph 10 of Paper Number 14, Applicant gratefully acknowledges withdrawal rejection of Claims 5 and 6 under 35 U.S.C. §112 (second paragraph).

In Paragraph 11 of Paper Number 8, the Examiner rejects Claims 1-4 and 9-12 under 35 U.S.C. §112 (first paragraph). To substantiate this rejection, the Examiner refers to proviso (ii) in Claim 1 and states that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skill in the art that the inventors, at the time the present application was filed, had possession of the claimed invention. This rejection is traversed. Reconsideration is requested in light of the following remarks.

During the recent personal interview, the Examiner requested a concordance of chemical structures and chemical names for the compounds specifically mentioned in the present application. In response, Applicant has attached hereto an Appendix that is a concordance of chemical structures and chemical names for the compounds mentioned on page 8, line 3 to page 9, line 23 of the present application. As the Examiner will see from the attached Appendix, in 16 of the 39 compounds, one of R^2 or R^3 is nitro and, in each of these 16 compounds, R^1 is not benzyl. Accordingly, as discussed at the recent personal interview, Applicant submits that the specification as originally filed contains ample support for proviso (ii) in Claim 1.

The Examiner is requested to reconsider and withdraw the rejection of Claims 1-4 and 9-12 under 35 U.S.C. §112 (first paragraph).

In Paragraph 12 of Paper Number 14, the Examiner rejected Claims 5, 6 and 13 under 35 U.S.C. §112 (second paragraph). As the Examiner will see, Claim 5 has now been rewritten such that it is independent of Claim 1 – this should alleviate the Examiner's concern in Paragraph 12(b) of Paper Number 14. Further, the provision of the Appendix hereto is responsive to the Examiner's

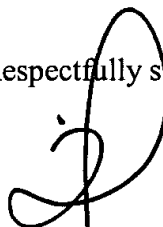
request for chemical structures for various of the compounds mentioned in the subject claims. Applicant has effected the Examiner's suggested amendment in Paragraph 12(c) of Paper Number 14. Accordingly, the Examiner is requested to reconsider and withdraw the rejection of Claims 5, 6 and 13 under 35 U.S.C. §112 (second paragraph).

It is believed that the above remarks and amendments submitted herein have placed this present application in condition for allowance. The Examiner has further concerns, she is encouraged to contact Applicant's undersigned agent at 416-862-5775. All correspondence should continue to be directed to our below listed address.

In view of the above amendments and remarks, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned agent may be reached by telephone at (416) 862-5775. All correspondence should continue to be directed to our below listed address.

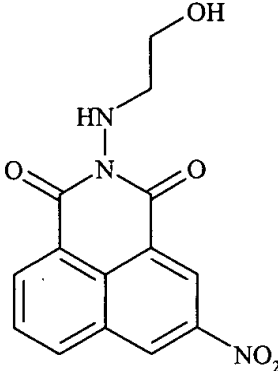
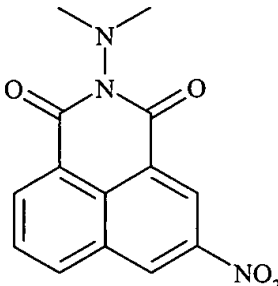
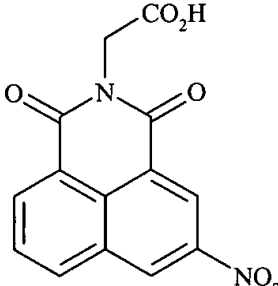
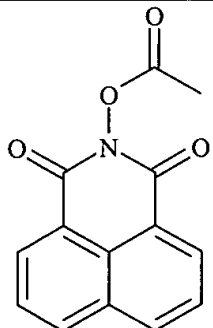
Respectfully submitted,

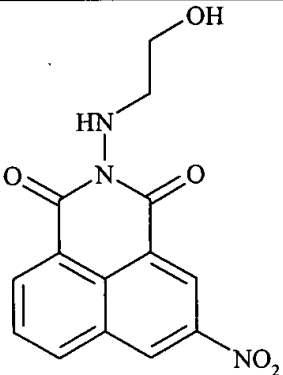
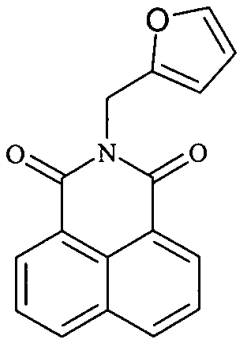
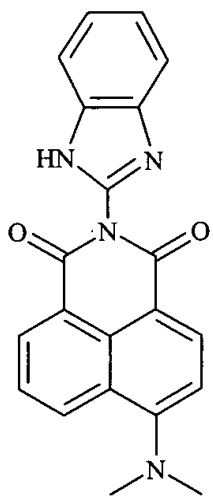


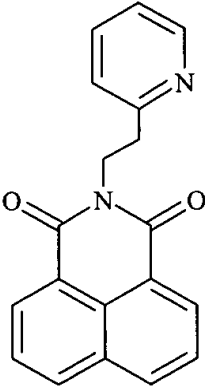
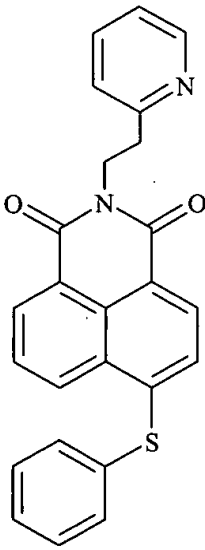
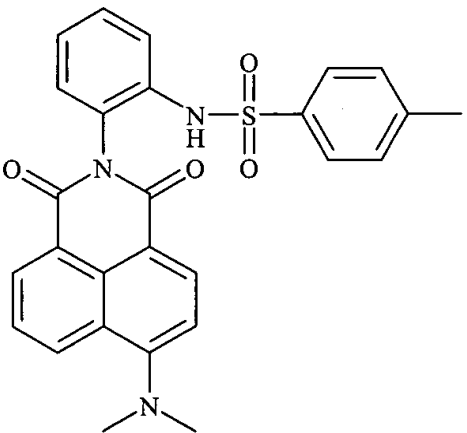
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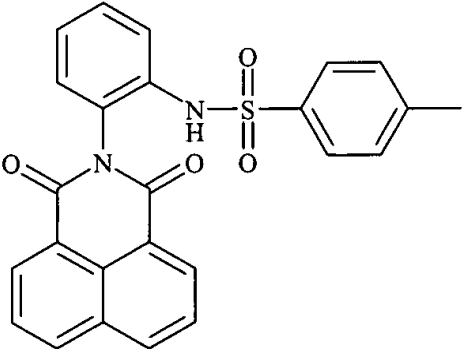
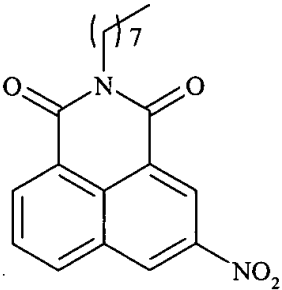
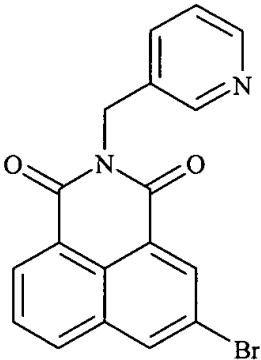
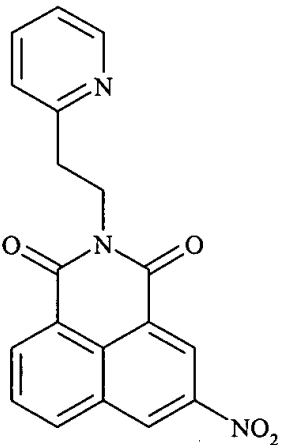
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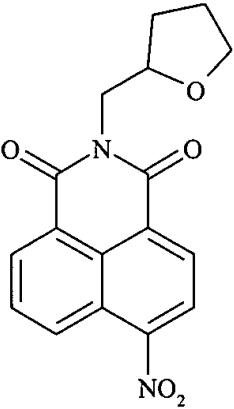
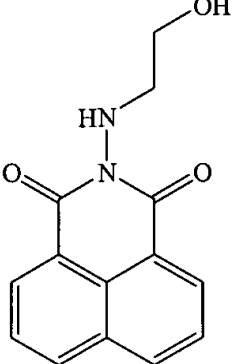
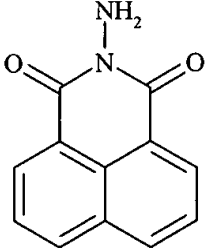
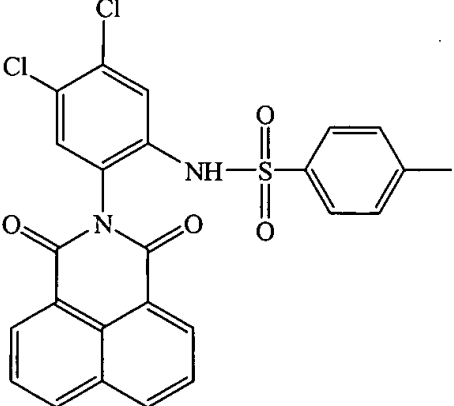
APPENDIX

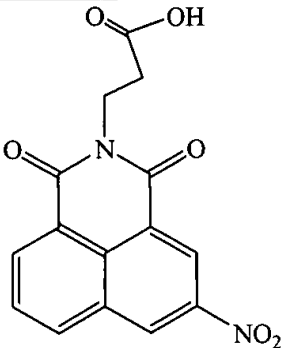
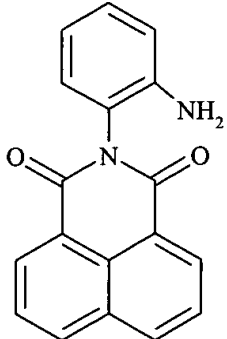
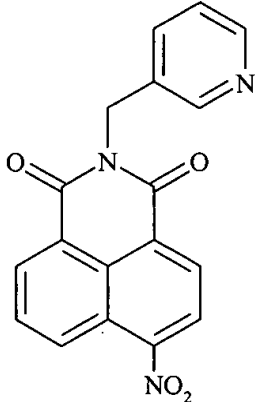
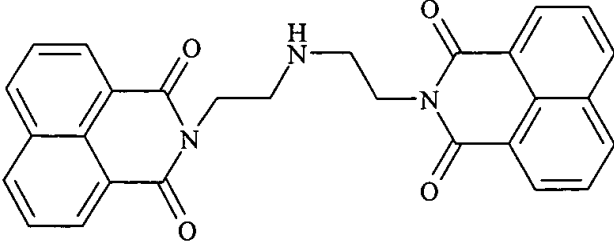
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N-dimethylamino-1,3-dioxo-5-nitro-1,2,3,4-tetrahydrobenzo[i]isoquinoline	
N-(1,3-dioxo-5-nitro-1,2,3,4-tetrahydrobenzo[i]isoquinoline)acetic acid	
N-acetoxy-1,3-dioxo-1,2,3,4-tetrahydrobenzo[i]isoquinoline	

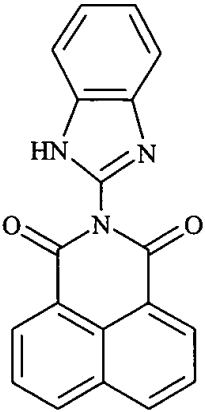
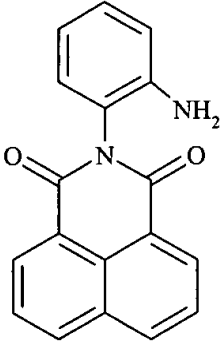
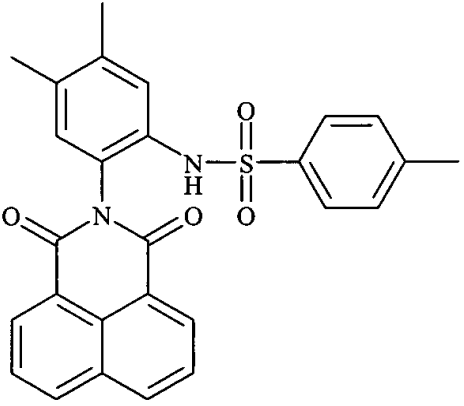
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N-(1,3-dioxo-5-nitro-1,2,3,4-tetrahydrobenzo[i]isoquinoline)aminoethanol	
N-furfuryl-1,8-naphthalimide	
6-(N,N-dimethylamino)-2-(benzimidazol-2-yl)naphthalimide	

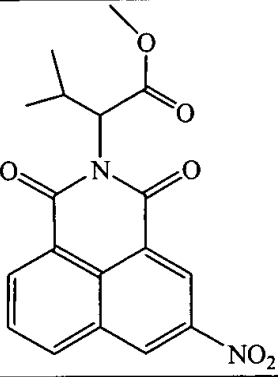
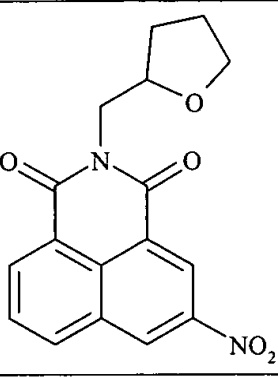
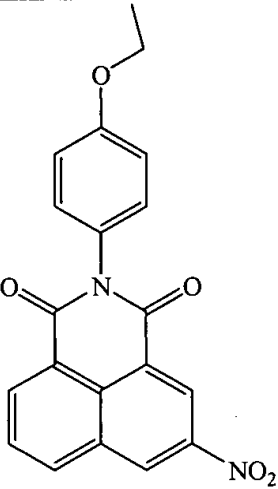
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N-(pyrid-2-ylethyl)-1,8-naphthalimide	
1,3-dioxo-6-phenylmercapto-N-(pyrid-2ylethyl)-1,2,3,4-tetrahydrobenzo[i]isoquinoline	
2-{2-(4-methylphenylsulphonamido)phenyl}-6-(N,N-dimethylamino)naphthalimide	

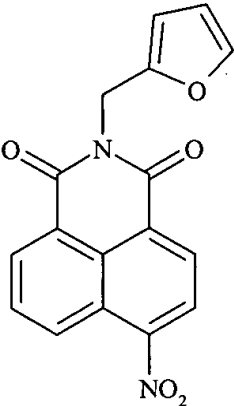
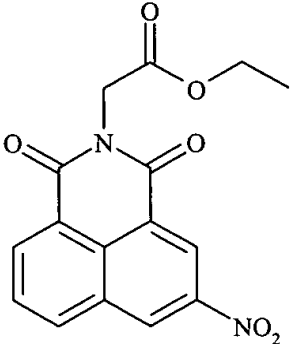
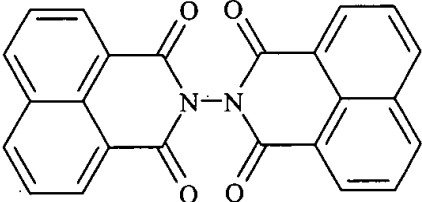
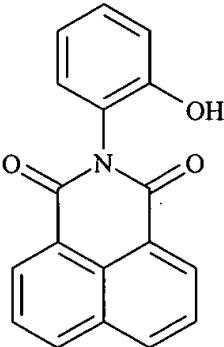
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N-octyl-5-nitronaphthalimide	
5-Bromo-1,3-dioxo-N-methylpyrid-3-yl-1,2,3,4-tetrahydrobenzo[i]isoquinoline	
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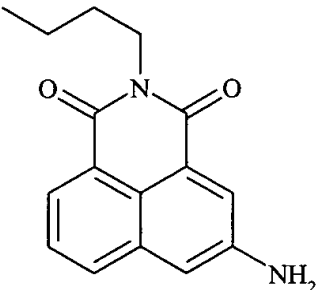
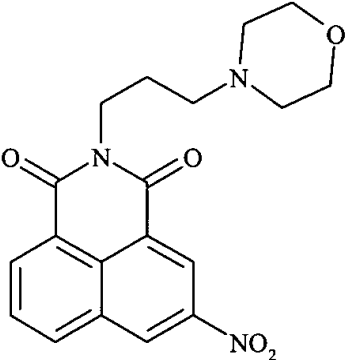
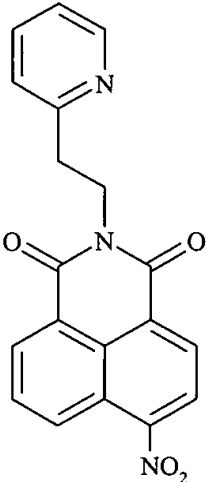
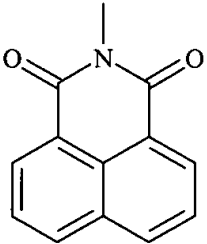
CHEMICAL NAME	CHEMICAL STRUCTURE
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N-(1,3-dioxo-1,2,3,4-tetrahydrobenzo[i]isoquinoline)aminoethanol	
Naphthalicacid-N-aminoimide	
2-{2-(4-methylbenzsulphonamido)-4,5-dichlorophenyl}naphthalimide	

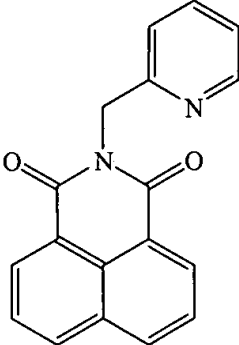
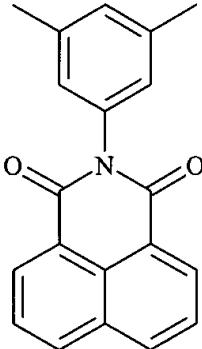
CHEMICAL NAME	CHEMICAL STRUCTURE
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6-nitro-2-(pyrid-3-methyl)naphthalimide	
3-amino-7,4-bis(ethyl-1,3-dioxo)-1,2,3,4-tetrahydrobenzo[i]isoquinoline	

CHEMICAL NAME	CHEMICAL STRUCTURE
2-(benzimidaz-2-yl)-1,3-dioxo-1,2,3,4-tetrahydrobenzo[i]isoquinoline	
2-(2-aminophenyl)naphthalimide	
1,3-dioxo-2-{4,5-dimethyl-2-(4-methylphenylsulphonamido)phenyl}-1,2,3,4-tetrahydrobenzo[i]isoquinoline	

CHEMICAL NAME	CHEMICAL STRUCTURE
3-methyl-3-(1,3-dioxo-5-nitro(1H,3H)benz[de]isoquinolyl)butyric acid methylester	
1,3-dioxo-N-methyltetrahydrofurfur-2-yl-5-nitro-1,2,3,4-tetrahydro[i]isoquinoline	
N-(4-ethoxyphenyl)-5-nitronaphthalimide	

CHEMICAL NAME	CHEMICAL STRUCTURE
6-nitro-2-(furfuryl)naphthalimide	
ethyl 5-nitro-1,3-dioxo-1H-benz[de]isoquinoline-2-3H-acetate	
naphthalicacid-N,N'-diimide	
2-(2-hydroxyphenyl)naphthalimide	

CHEMICAL NAME	CHEMICAL STRUCTURE
5-amino-N-butyl-naphthalimide	
1,3-dioxo-5-nitro-n-propylmorpholino-1,2,3,4-tetrahydrobenzo[i]isoquinoline	
6-nitro-2-(pyrid-2ylethyl)naphthalimide	
N-methylnaphthalimide	

CHEMICAL NAME	CHEMICAL STRUCTURE
N-(pyrid-2-ylmethyl)naphthalimide	
N-(3,5-dimethylphenyl)-1,8-naphthalimide	
6-bromo-N-dimethylamino-1,3-dioxo-1,2,3,4-tetrahydrobenzo[i]isoquinoline	